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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,885	03/16/2001	John L. Margrave	11321-P026US	7715
759	04/23/2003			
Attention: Ross Spencer Garsson Winstead Sechrest & Minick P.C. Suite 800			EXAMINER HENDRICKSON, STUART L	
Austin, TX 787	701		ARTONII	PAPER NUMBER
			1754	3
			DATE MAILED: 04/23/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

			AC-
	Application No.	Applicant(s)	
Office Action Summary	Examiner And	Group Art Un	uit
-The MAILING DATE of this communication appears	on the cover sheet he	recath the correspondence	addmos
	Oll ule cover spect so	riedur ure correspondence	e auuress—
Period for Reply	· }		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO OF THIS COMMUNICATION.		MONTH(S) FROM THE	
 Extensions of time may be available under the provisions of 37 CFR 1 from the mailing date of this communication. If the period for reply specified above is less than thirty (30) days, a re If NO period for reply is specified above, such period shall, by default Failure to reply within the set or extended period for reply will, by stat Any reply received by the Office later than three months after the mail term adjustment. See 37 CFR 1.704(b). 	eply within the statutory mining t, expire SIX (6) MONTHS from tute, cause the application to	imum of thirty (30) days will be common the mailing date of this common become ABANDONED (35 U.S	considered timely. nunication. S.C. § 133).
Status			
☐ Responsive to communication(s) filed on			•
☐ This action is FINAL.		•	
 Since this application is in condition for allowance except accordance with the practice under Ex parte Quayle, 1935 	for formal matters, pros 5 C.D. 1 1; 453 O.G. 213.	ecution as to the merits	is closed in
Disposition of Claims			·
Claim(s)	· · · · · · · · · · · · · · · · · · ·	is/are pending in the	application.
Of the above claim(s)			• •
Claim(s)	· · · · · · · · · · · · · · · · · · ·	is/are allowed.	
Claim(s)		is/are rejected.	
□ Claim(s)		• .	
□ Claim(s)		are subject to restrict	ion or election
Application Papers		requirement	
☐ The proposed drawing correction, filed on		☐ disapproved.	
☐ The drawing(s) filed on is/are object	ted to by the Examiner		
☐ The specification is objected to by the Examiner.			
☐ The oath or declaration is objected to by the Examiner.			
Priority under 35 U.S.C. § 119 (a)–(d)			
☐ Acknowledgement is made of a claim for foreign priority un	nder 35 U.S.C. § 119 (a)	-(d).	
☐ All ☐ Some* ☐ None of the:	•		
☐ Certified copies of the priority documents have been re	_		
☐ Certified copies of the priority documents have been re	• •	5.	L
□ Copies of the certified copies of the priority documents			
in this national stage application from the International *Certified copies not received:	•	• • • • • • • • • • • • • • • • • • • •	
Attachment(s)			•
☐ Information Disclosure Statement(s), PTO-1449, Paper No	/(s) 🗀 In	sterview Summary, PTO-413	a
Notice of Reference(s) Cited, PTO-892	• •	otice of Informal Patent App	
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948		ther	
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Office Ac	ction Summary		

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• Art Unit: 1754

It appears the claims should be renumbered. There was never a claim 19.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims pending are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims pending of copending Application No. 09/810150. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presence of solvent appears necessary, and thus inherent, for formation of functionalized tubes.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 52-96 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haddon et al. '262.

Haddon teaches functionalized nanotubes in the figures and column 1. It appears that the sidewalls are inherently attacked, even though not depicted. The process steps (temperature etc.) do not limit the product being claimed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.

Stuart Hendrickson examiner Art Unit 1754